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EXAMINER

ZHAO, DAQUAN

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,969	<b>Applicant(s)</b> IKEDA ET AL.	
	<b>Examiner</b> DAQUAN ZHAO	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 67-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 67-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/6/2007;9/28/2007;10/3/2005;7/20/2005</u> .                 | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Claim Objections***

Claim 68 is objected to because of the following informalities: "The manufacturing method of claim 67" should be changed to --The playback apparatus of claim 67--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 78-84 are rejected under 35 U.S.C. 101 because claims are directed non-statutory subject matter.

Claim 78 recites a recording medium has package area, which is considered to be nonfunctional descriptive material. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *In re Warmerdam*, 33 F.3d 1354, 1360-61, 31 USPQ2d 1754, 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diamond v. Diehr*, 450 U.S. 175, 185-86, 209 USPQ 1, 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137

(CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.”

Claims 79-83 are also affected.

Claim 84 is directed to a program which is a non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 67-85 are rejected under 35 U.S.C. 102(b) as being anticipated by Onoda et al (JP 2002247526, an official translation is provided).

For claim 67, Onoda et al teach a playback apparatus comprising: a secondary recording medium having a package area assigned to an optical disc to be mounted to the playback apparatus (e.g. figure 1, medium 63 has packet structure shown in figure 3

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and paragraphs 36-37, wherein the medium 63 can be CD, DVD hard disc etc..., see paragraph 19);

a specifying unit operable to, when the optical disc is mounted to the playback apparatus, obtain medium information from the optical disc and specify the package area in the secondary recording medium that corresponds to the obtained medium information (e.g. para. 5, synchronously, playback the video data of the DVD and the audio or sub-picture data from the external medium which has packet structure as discussed above); a first reading unit operable to read a first digital stream from the optical disc; a second reading unit operable to read a second digital stream from the specified package area; and a playback unit operable to play back, in synchronization, data included in the first digital stream and data included in the second digital stream (e.g. figure 1, device 12 and device 62 read data from the DVD 11 and external medium 63, respectively).

Claim 78 is rejected for the same reasons as discussed in claim 67 above, wherein the video data of the DVD is in synchronous with the audio or sub-picture of the external medium reads on "the package area has a second digital stream and correspondence information recorded thereon, the correspondence information showing the second digital on the recording medium in correspondence with the first digital stream."

Claims 84 and 85 are rejected for the same reasons as discussed in claim 67 above.

For claim 68, Onoda et al teach the secondary recording medium has correspondence information recorded thereon, the correspondence information showing the first digital stream in correspondence with the second digital stream, and the readings by the first and the second reading units are performed based on the correspondence information (e.g. the video data of the DVD is in synchronous with the audio or sub-picture of the external medium).

For claims 69 and 79, Onoda et al teach the correspondence information is playlist information, the playlist information showing a starting point and an ending point of a playback section in the first digital stream in correspondence with a starting point and an ending point of a playback section in the second digital stream; the playback apparatus comprises a playback control unit operable to interpret the playlist information; and the readings by the first and the second reading units and the playback by the playback unit are performed based on a result of the interpretation by the playback control unit (e.g. para. 24 and 31, and figure 2, the program chain information (PGCI) corresponds to a playlist because the PGCI has start VOBUs and end VOBUs and the address of the audio & sub-picture to be synchronized at the corresponding VOBUs position are also scripted as synchronicity information, to synchronize the video of the VOBUs in the DVD and the audio or sub-picture from the external medium, the system must replace the audio or sub-picture of the DVD with the audio and sub-picture from the external medium during playback).

For claims 72 and 76, Onoda et al teach the playback unit includes: a first demultiplexer operable to demultiplex a part of the first digital stream to obtain pieces of

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video data and pieces of first audio data (e.g. para. 9, separation unit 16); a second demultiplexer operable to demultiplex a part of the second digital stream to obtain pieces of second audio data (e.g. para. 14-17, the operation input unit and the system operation unit change the current playback audio stream with the audio stream in the external medium, wherein the system control unit 50 controls the selector 40 to select audio from the external medium); a video decoder operable to decode video data (e.g. 12, video decoder 31); an audio decoder (device 32); and a supplying subunit operable to supply either the pieces of first audio data or the pieces of second audio data to the audio decoder (e.g. selector 40), wherein the playback unit achieves the playback in synchronization by, in a case where the pieces of second audio data are supplied to the audio decoder, synchronizing the decoding of each piece of second audio data by the audio decoder with the decoding of each piece of video data by the video decoder (e.g. para. 17).

For claim 73, Onoda et al a system register that stores therein a parameter showing a status setting of the playback apparatus, wherein whether the audio decoder decodes the pieces of first audio data belonging to the first digital stream or the pieces of second audio data belonging to the second digital stream is determined according to the parameter in the system register (e.g. para. 32-33, Flag tells the valid audio).

For claim 70, Onoda et al teach Storage information is recorded in the package area, the playback control unit takes out the playlist information from a location within the package area being indicated by the storage information, so as to interpret the playlist information (e.g. para. 31-32, PGCI table).

For claim 71, Onoda et al teach the secondary recording medium has a program recorded thereon, the program showing a procedure for playback control of the first and the second digital streams using the playlist information, the playback apparatus comprises an execution module for executing the program recorded on the secondary recording medium, and the playback control unit interprets the playlist information based on a function call within the program (e.g. page 3 of Onoda et al).

For claim 74, Onoda et al teach a control unit operable to display a menu, wherein the parameter in the system register is updated in accordance with a selection from the displayed menu (e.g. para. 3-7, user must able to choose a different language from a list of languages).

For claim 75, Onoda et al teach a receiving unit operable to receive a user operation, wherein the parameter in the system register is updated in accordance with the user operation received by the receiving unit (e.g. para. 3-7, user must able to choose a different language from a list of languages, selection unit).

For claim 80, Onoda et al teach having a program recorded thereon, the program showing a procedure for playback control using the playlist information (e.g. para. 31-35, PGCI).

For claim 81, Onoda et al teach the procedure for playback control is to perform playback using the playlist information under a condition, and the condition is defined by a system parameter which shows a status setting of a playback apparatus (e.g. para. 31-35, PGCI).

For claim 82, Onoda et al teach the first digital stream includes video data and audio data, and the second digital data includes audio data (e.g. para. 25-26 and para 6).

For claim 83, Onoda et al teach the first digital stream includes video data and sub-image units, and the second digital stream includes sub-image units (e.g. para. 25-26 and para 6).

For claim 77, Onoda et al teach a generating unit operable to generate a virtual package indicating a file constitution in which a file on the optical disc is combined with a file in the specified package area, wherein the first reading unit and the second reading unit read the first digital stream and the second digital stream that are in the files indicated by the virtual package, from the optical disc and the secondary recording medium (e.g. para. 6, selection mechanism).

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Amir et al (US 6,907,570 B2); Tsujii et al (US 2005/0,163,488 A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/  
Examiner, Art Unit 2621  
Daquan Zhao

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621